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EXAMINER	
DEXTER, C	
ART UNIT	PAPER NUMBER
3724	

DATE MAILED: 06/03/98

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.
08/659,046

Applicant(s)
Bauer et al.

Examiner
Clark F. Dexter

Group Art Unit
3724



☒ Responsive to communication(s) filed on Mar 20, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 6-8 and 12-16 is/are pending in the application.

Of the above, claim(s) 13 and 14 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 6-8, 12, 15, and 16 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/508,255.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on March 20, 1998 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/659,046 is acceptable and a CPA has been established. An action on the CPA follows.

Election/Restriction

2. Newly submitted claims 13 and 14 are directed to an invention that is independent or distinct from the invention originally claimed because they are directed to different disclosed species as described in the restriction requirement (paper #3).

Since applicant is prosecuting the same invention as in the prosecution of the parent application, and has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 13 and 14 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. It is noted that claims 8 and 12 are directed to subject matter which was originally restricted from the elected subject matter. However, due to the newly-discovery of prior art, these claims have been rejoined.

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Claim Rejections - 35 USC § 112

3. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification and drawings do not appear to provide support for shearing elements which each comprise a disc (set forth in claim 7) in combination with each shearing element comprising one of a pair of forceps as set forth in claim 12. ✓ Rather, support is provided for the shearing elements comprising either a disc or forceps, but not both.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 6, 8 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Shearer.

Shearer discloses a cutting tool which meets every structural limitation of the claimed invention in the manner as Figure 3, wherein the cutting tool includes a cutting element and a handle attached thereto. It is noted that using two of these cutting tools to form the claimed hand-held tool, whereby the sides having the cutting edges are held so that they are directly

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touching each other, is considered a functional recitation of the intended use of the cutting tool (i.e., it is considered an intended use of the forceps of Shearer).

6. Claims 6-8, 12, 15 and 16, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by British Patent 20,244 (GB '244).

GB '244 discloses a cutting tool in Figures 1-5 (particularly as shown in Figure 3) with every structural limitation of the claimed invention as best understood (particularly with respect to the rejection under 35 USC 112 described above) including a disc (e.g., E,K,I) having a slot (e.g., formed by K and I) forming a cutting edge at one side of the disc (e.g., the right side as viewed in Figure 2), and a handle (e.g., A,C) connected to the disc. It is noted that using two of these cutting tools to form the claimed hand-held tool, whereby the sides having the cutting edges are held so that they are directly touching each other, is considered a functional recitation of the intended use of the cutting tool (i.e., it is considered an intended use of the cutter of GB '244).

Claim Rejections - 35 USC § 102/103

7. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

8. Claim 6 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stolpe.

Stolpe discloses a cutting apparatus (e.g. in Figure 2) with every structural limitation of the claimed invention including an upper shearing element (connected to e'), a lower element (connected to f'), and a means (e.g. b,l',l') for rotating the elements counter to one another.

In the alternative, if it is argued that Stolpe does not include handles which are to be grasped by hand, it is the Examiner's position that the threaded/linkage mechanism (e.g., p,q,r,s,t) of Stolpe is provided to obtain a mechanical advantage to facilitate rotation of the arms/handles (e.g., g,o). It is known to those skilled in the art that mechanisms used to gain mechanical advantage have there cost. One "cost" is reduced speed of operation. Therefore, it would have been obvious to one having ordinary skill in the art, when using the device of Stolpe to cut softer material (e.g., soft iron or iron products) to remove the linkage from the arms/handles of Stolpe so that they can be pivoted more quickly and improve manufacturing efficiency (i.e., to cut workpieces more quickly).

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Claim Rejections - 35 USC § 103

9. Claim 7 is rejected under 35 U.S.C. § 103 as being unpatentable over Stolpe in view of Schweitzer.

Stolpe discloses a cutting apparatus (e.g. in Figure 2) which discloses or suggests almost every structural limitation of the claimed invention including a handle (e',f) attached respectively to each shearing element but lacks each shearing element comprising a disc having a slot with a cutting edge extending from the outer periphery toward the center. Schweitzer discloses a cutting apparatus wherein the shearing elements each include a disc having a slot with a cutting edge as claimed wherein the slot narrows towards the center, and teaches that peripheral slots are provided for inserting lengths of rebar therein for cutting the rebar. Therefore, it would have been obvious to one having ordinary skill in the art to provide the discs of Schweitzer with slots therein on the cutting apparatus of Stolpe to gain the benefits taught by Schweitzer including that described above.

Response to Arguments

10. Applicant's arguments filed January 20, 1998 have been fully considered but they are not persuasive.

In the third paragraph on page 5 of the amendment, applicant argues that the device of Stolpe is not a hand-held tool and that this limitation in the preamble is structural. The Examiner respectfully disagrees and maintains the position that there is no structure in the body of the claim

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to structurally distinguish the invention over Stolpe. Further, it is noted that the actual size of the device of Stolpe is not known, however, it is well settled case law that a change in size is generally recognized as being within the level of ordinary skill in the art. The size of Stolpe could very well be a size wherein it can be hand-carried, or hand-held. Further, applicant citation beginning in line 8 on page 5 concerns the preamble of a claimed process. The Examiner agrees that the preamble must be given significant patentable weight in process claims. However, the claims of the present invention are directed to a device.

In the third paragraph on page 8, applicant alleges that there is an inconsistency with contending that the written description is inadequate while asserting that the same invention is obvious. However, it is respectfully submitted that such a situation does not present an inconsistency at all. Examiners are directed to apply a prior art rejection, whenever possible, to the invention as best understood. Thus, in the present situation, the prior art rejection was made to the claimed invention as best understood, notwithstanding the rejection under 35 USC 112.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax number for this group is (703)305-3579.

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Communications via Internet e-mail regarding this application, other than those under 35 USC 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rinaldi.rada@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 USC 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cf
May 26, 1998